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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

TATE, CHRISTOPHER ROBIN

ART UNIT

PAPER NUMBER

1651

DATE MAILED: 08/22/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
09/904,144

Applicant(s)  
Bahnsen

Examiner  
Christopher Tate

Art Unit  
1651



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on May 10, 2002
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claims 1-37 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other:

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## **DETAILED ACTION**

### ***Election/Restriction***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-9, 11, 12, 16, 17, 23, and 25-31, drawn to a first method involving various related assays directed to analyzing a cell via placing cells in a viscous solution, such as one containing methyl cellulose, and performing motility analyses the cells, classified in class 435, subclass 4, for example.
- II. Claim 10, drawn to a second method directed to placing cells in a solution and identifying and quantifying short lived effects or transient effects of added moiety on motility of the cells, classified in class 435, subclass 29, for example.
- III. Claims 13-15, drawn to a third method directed to placing cells in a solution and analyzing the cells in a 2D or 3D environment, classified in class 435, subclass 30, for example.
- IV. Claims 18 and 24, drawn to a fourth method directed to placing cells in a solution which contains a thin layer, classified in class 435, subclass 4, for example.
- V. Claims 19-22, drawn to a fifth method directed to placing cells in a solution, adding a protein to the solution and analyzing one or more effects of the protein on the cells, classified in class 435, subclass 24, for example.

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- VI. Claim 32, drawn to a sixth method directed to placing cells in a solution and measuring motility for adherent or nonadherent cells therein, classified in class 435, subclass 29, for example.
- VII. Claim 33, drawn to a seventh method directed to placing cells in a solution and measuring motility thereof using visible and fluorescent images, classified in class 435, subclass 7.9, for example.
- VIII. Claim 34, drawn to an eighth method directed to placing cells in a solution and measuring swimming vs moving of cells therein in a 2D plane, classified in class 435, subclass 29, for example.
- IX. Claim 35, drawn to a ninth method directed to placing cells in a solution and measuring the effect tilt has on cell motion by changing the angle a plate is tilted on which the cell is disposed, classified in class 435, subclass 29, for example.
- X. Claim 36, drawn to a tenth method directed to placing cells in a solution having cellulose, removing methyl cellulose, treating the cells with a desired material, and reintroducing methyl cellulose into the solution, classified in class 435, subclass 30, for example.
- XI. Claim 37, drawn to an eleventh method directed to placing cells in a solution and identifying specific subpopulations of cells of similar phenotype therein , classified in class 435, subclass 30, for example.

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The methods of Groups I-XI, as evidenced by the claims themselves, are directed to different inventions which are not connected in design, operation, and/or effect. These methods are independent since they are not disclosed as capable of use together, they have different modes of operation, they have different functions, and/or they have different effects. One would not have to practice the various methods at the same time to practice just one method alone.

The several inventions above are independent and distinct, each from the other. The search for each of the above inventions is not co-extensive particularly with regard to the literature search. Further, a reference which would anticipate the invention of one group would not necessarily anticipate or even make obvious another group. Finally, the consideration for patentability is different in each case. Thus, it would be an undue burden to examine all of the above inventions in one application.

Please note that the Examiner assigned to your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Christopher R. Tate. Further, any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher R. Tate whose telephone number is (703) 305-7114. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Wityshyn, can be reached at (703) 308-4743. The Group receptionist may be reached at (703) 308-0196. The fax number for art unit 1651 is (703) 308-4242.



Christopher R. Tate  
Primary Examiner, Group 1651